

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TYLER DIVISION**

**Intellectual Ventures I LLC and
Intellectual Ventures II LLC,**

Plaintiffs,

V.

**HCC Insurance Holdings, Inc.,
HCC Life Insurance Company,
HCC Specialty Insurance Company,
HCC Specialty Underwriters, Inc.,
Houston Casualty Company, and
Professional Indemnity Agency, Inc.,**

Defendants.

CIVIL ACTION NO. 6:15-CV-660-JRG

JURY TRIAL DEMANDED

JOINT STATUS REPORT

Per the Court's Order (Dkt. No. 126), the parties submit this Joint Status Report regarding the status of the claims of United States Patent No. 7,156,177 B2 ("177 patent"). This matter is currently stayed. As described below, the Patent Trial and Appeal Board ("PTAB") has instituted an *inter partes* review of the sole remaining claim asserted in this matter (IPR2016-01434), and as a petitioner and real party at interest in that IPR, HCC will be bound by its result. As a result, the HCC defendants respectfully request the Court to continue the stay. The IV plaintiffs do not oppose this request.

On January 17, 2017, the Patent Trial and Appeal Board (“PTAB”) entered separate final written decisions in IPR2015-01706 (Exhibit A) and IPR2015-01707 (Exhibit B) determining, collectively, that Great West and Bitco had met their burden of showing, by a preponderance of the evidence, that claims 11–13 and 15–20 of the ’177 patent are unpatentable. *See Great W.*

Cas. Co. v. Intellectual Ventures II LLC, Case IPR2015-01706 (PTAB Jan. 17, 2017) (Paper 28); *Great W. Cas. Co. v. Intellectual Ventures II LLC*, Case IPR2015-01707 (PTAB Jan. 17, 2017) (Paper 30). Claim 14 of the '177 remains.

HCC, along with Oracle, filed a petition for *inter partes* review, and on January 17, 2017, the PTAB instituted an IPR against all the claims of '177 Patent asserted in this action. *See Oracle v. Intellectual Ventures I LLC*, IPR2016-01434, Paper 13 at 31–32 (Exhibit C). The final written decision on this IPR is due by January 17, 2018. *See* 37 C.F.R. § 42.100(c). As a petitioner and real party at interest, HCC will be bound by the result of this IPR.

Great West and Bitco have filed a follow-on petition, which is currently pending as IPR2016-01534. The PTAB has ordered the parties to file limited briefing as to the effect of the final written decisions in IPR 2016-01706 and IPR 2016-01707 on IPR 2016-01534.

Because HCC will be bound by the result of IPR2016-01434 and because IPR2016-01434 will consider the validity of the sole remaining patent claim asserted in this action, the HCC defendants respectfully request the Court to continue the stay. IV does not oppose HCC's request.

Dated: January 31, 2017.

Respectfully submitted,

/s/ Derek Gilliland with permission

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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing document was filed electronically in compliance with Local Rule CV-5(a) and served via the Court's electronic filing system on all counsel who have consented to electronic service on January 31, 2017.

/s/ Jon C. Rice

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